

# PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number:

06975-179001

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.

Date of Deposit

Signature

Typed or Printed Name of Person Signing Certificate

Application Number

10/032,006

Filed

December 31, 2001

First Named Inventor

Richard Rodriquez-Val et al.

Art Unit

2171

Examiner

Sana A. Al-Hashemi

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached 4 sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒
attorney or agent of record 41,265

(Reg. No.)

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

20250

Signature

for

W. Karl Renner

Typed or printed name

(202) 783-5070

Telephone number

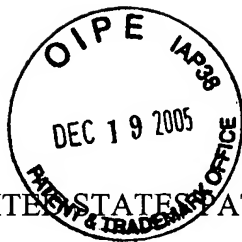
December 19, 2005

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒

Total of 1 forms are submitted.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Richard Rodriguez-Val et al.      Art Unit : 2171  
Serial No. : 10/032,006      Examiner : Sana A. Al-Hashemi  
Filed : December 31, 2001  
Title : AUTOMATIC VERIFICATION OF A USER

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Claims 29-33 and 36 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Durinovic-Johri et al (U.S. Patent No. 5,699,514).

Applicants respectfully traverse this rejection.

Applicants specifically ask the panel to review the following issues:

1. Durinovic-Johri fails to support the presently pending rejection of claims 29-33 and 36 under 35 U.S.C. § 102(e) as it fails to disclose or suggest all features and limitations of independent claims 29 and 36. Specifically, Durinovic-Johri fails to describe or suggest “identifying a formatting characteristic of the data received” and “comparing the formatting characteristic against a format criteria,” as recited in claim 29 and similarly recited in claim 36.

2. The Advisory Action provides no arguments against Applicant’s prior response, which points out these shortcomings.

Discussion of Issues:

1. Durinovic-Johri fails to support the presently pending rejection of claims 29-33 and 36 under 35 U.S.C. § 102(e) as it fails to disclose or suggest all features and limitations of independent claims 29 and 36. Specifically, Durinovic-Johri fails to describe or suggest “identifying a formatting characteristic of the data received” and “comparing the formatting characteristic against a format criteria,” as recited in claim 29 and similarly recited in claim 36.

Independent claim 29 recites a method for enabling a user configuration. The method includes “receiving data regarding a communication characteristic, identifying a formatting characteristic of the data received, comparing the formatting characteristic against a format criteria, and enabling a user configuration based on results of the comparison between the formatting characteristic and the format criteria.”

To illustrate, in the last paragraph of page 13 and the first paragraph of page 14, the specification describes checking the format of a received telephone number for the proper number of digits and/or for the use of permissible numbers rather than impermissible letters.

Durinovic-Johri fails to disclose the subject matter of claim 29, as it compares content of a received message against content stored in a database to glean substantive similarities and distinctions between the two. As such, Durinovic-Johri does not teach or suggest comparing the format of a received message against stored formatting characteristics, as required by claim 29.

The Final Office Action cites to a substantive comparison performed by Durinovic-Johri of received content against stored content, and wrongly suggests that this substantive comparison meets the claimed format comparison. See Office Action at page 6, lines 3-4. However, the portion of Durinovic-Johri referenced by the Final Office Action for this purpose (column 4, line 64 to column 5, line 5 and column 7, lines 21-25) describes a comparison of a received code against a stored code retrieved from a database, looking for an exact match between the two. See col. 7, lines 21-25 (illustrating an example of such a database including the stored codes). In doing so, Durinovic-Johri suggests comparison of the received content against nothing other than corresponding stored content, and does not disclose comparison of the format of the received content against the format of the corresponding stored content. Durinovic-Johri nowhere

suggests access to format criteria, nor does it suggest a comparison of the formatting characteristics of data against such format criteria.

The impact of differences between the technology described by Durinovic-Johri and the subject matter of claim 29 is perhaps best illustrated with an example. If we assume entry of 999-999-9999, Durinovic-Johri will compare some version of that numerical sequence to numbers that it maintains in its database. The presence of an exact match will inform some future action, and the absence of an exact match will inform some other future action. However, other than the presence or absence of an exact match between the numerical sequence, Durinovic-Johri does not suggest the existence of any other information to be gleaned from the received entry.

By contrast, the subject matter of claim 29 is not limited to the existence or absence of exact matches between a received entry and stored information. Rather, that subject matter enables user configurations irrespective of the existence or absence of an exact match between a received entry and stored information. More pointedly, claim 29 recites that the format of an entry is compared against format criteria, and action is taken based on this format comparison, without regard for whether the entry matches some database content in substance. Thus, in the example above, it is not relevant to claim 29 whether or not a database entry exists with the numerical sequence 999-999-9999. Rather, and irrespective of the existence or absence of an exact match between a received entry and stored information, if the format of 999-999-9999 matches stored format criteria, user configuration may be enabled.

While an exact match by Durinovic-Johri may imply the existence of a match between the format of entered and stored data, Durinovic-Johri clearly does not make a comparison of format. As illustrated above, Durinovic-Johri is therefore unable to determine whether to enable user configurations in the absence of a comparison of the substance of the data entered against the data stored, or in a situation where the received data that does not match the stored data has a compliant format. While neither of these scenarios is required by the claim, they illustrate the differences between claim 29 and Durinovic-Johri.

Claim 36 recites a system configured to perform similarly to the method of claim 29.

For at least these reasons, applicants respectfully request reconsideration and withdrawal of the rejection of claims 29-33 and 36.

Applicant : Richard Rodriquez-Val et al.  
Serial No. : 10/032,006  
Filed : December 31, 2001  
Page : 4 of 4

Attorney's Docket No.: 06975-179001 / Commerce 04

2. The Advisory Action provides no arguments against Applicant's prior response, which points out these shortcomings.

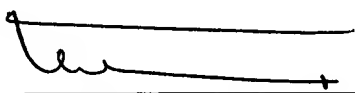
The Advisory Action includes absolutely no arguments with respect to Applicant's response to the final Office Action.

In view of the above, all of the claims should be in condition for allowance. A formal notice of allowance is thus respectfully requested.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 12/19/05

 L0250  
\_\_\_\_\_  
for W. Karl Renner  
Reg. No. 41,265

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331